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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,546	01/29/2001	Robert Barra	P-1 CIP MG	9594
28752	7590	05/17/2004	EXAMINER	
LACKENBACH SIEGEL, LLP LACKENBACH SIEGEL BUILDING 1 CHASE ROAD SCARSDALE, NY 10583			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/771,546

Applicant(s)

BARRA ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

This is in response to a letter for patent filed on January 29<sup>th</sup>, 2001 in which claims 1-45 are presented for examination. Claims 1-48 are pending in the letter.

### *Claim Objections*

1. Claim 28 is objected to because of the following informalities: Applicant disclose at the end of claim 28 "compare claim 26". This disclosure is improper. Appropriate correction is required.

### *Double Patenting*

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-33 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-30 of prior U.S. Patent No. 09/578,756. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 34-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomkow (U.S. PG Pub No. 2002/0144154).

6. As per claims 34, Tomkow teaches a method of transmitting information which contains a request for specified services on an e-mail system comprising: connecting a sending computer to a communication network; submitting the information from the sending computer to the communication network; inputting the information onto a website server; transmitting, by the website server, the information to a mail center; receiving the information at the mail center; creating a record of the information at the mail center; storing the information by the mail center; and sending an alert message to a receiving computer indicating that the information has been received (*see paragraphs 0006, 0029, 0030, 0192*).

7. As per claims 35, Tomkow teaches a method further comprising inputting the information into a software program on the website server that interprets the information (*see paragraphs 0006, 0029, 0030, 0192*).

8. As per claims 36, Tomkow teaches a method further comprising storing the record on a data storage system (*see paragraphs 0006,0029, 0030, 0192*).
9. As per claims 37, Tomkow teaches a method further comprising utilizing a Uniform Resource Locator in the alert message to point the receiving computer to the mail center to access the information (*see paragraphs 0006,0029, 0030, 0192*).
10. As per claims 38, Tomkow teaches a method further comprising retrieving the information by utilizing the Uniform Resource Locator (*see paragraphs 0006,0029, 0030, 0192*).
11. As per claims 39, Tomkow teaches a method wherein the information includes an authentication database (*see paragraphs 0006,0029, 0030, 0192*).
12. As per claims 40, Tomkow teaches a method further comprising confirming by the mail center that receiving computer has received the information (*see paragraphs 0006,0029, 0030, 0192*).
13. As per claims 41, Tomkow teaches a method for transmitting information that contains a request for specified services from an e-mail service comprising: composing information on a sending computer; sending the information, which includes an authentication database, to a software program on the sending computer; comparing the authentication database with a

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database on the sending computer; sending the information from the sending computer to a mail center; processing the information at the mail center; and sending the information from the mail center to a receiving computer (*see paragraphs 0006,0029, 0030, 0192*).

14. As per claims 42, Tomkow teaches a method further comprising authenticating the receiving computer (*see paragraphs 0006,0029, 0030, 0192*).

15. As per claims 43, Tomkow teaches a method further comprising retrieving the message from the software program (*see paragraphs 0006,0029, 0030, 0192*).

16. As per claims 44, Tomkow teaches a method further comprising utilizing the mail center to authenticate the receiving computer (*see paragraphs 0006,0029, 0030, 0192*).

17. As per claims 45, Tomkow teaches a method further comprising confirming by the mail center that receiving computer has received the information (*see paragraphs 0006,0029, 0030, 0192*).

### ***Conclusion***

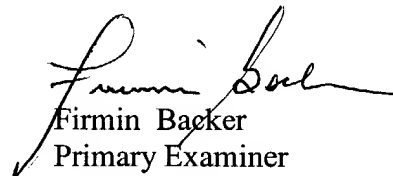
18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Firmin Backer  
Primary Examiner  
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May 12, 2004